



IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicants: CHO, Dong S. Conf.: 7087
Application No.: 09/927,398 Group: 2812
Filed: August 13, 2001 Examiner: Stacy Whitmore
For: USER INITIATED MICROCODE MODIFICATION

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REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

September 2, 2003

Sir:

In response to the Examiner's Restriction Requirement dated July 31, 2003, the following election and remarks are respectfully submitted in connection with the above-identified application.

ELECTION REQUIREMENT

The Examiner has set forth an Restriction Requirement as follows:

Group I, claims 1-2, drawn to an instruction decode unit as having a user instruction selector;

Group II, claims 3-8, drawn to an instruction decode unit having an instruction code selector which encrypts instruction code; and

Group II, claims 9-14, drawn to an apparatus comprising a selector for combining first and second microcodes.

ELECTION

In order to comply with the Examiner's Restriction Requirement, Applicants provisionally elect Group II, claims 3-8, for prosecution in the present application. Applicants reserve the right to file a Divisional application directed to the non-elected claims at a later date, if so desired.

This requirement for restriction is respectfully traversed for the reasons set forth below.

REMARKS

Applicants respectfully submit that the Examiner has failed to meet the required burden of showing that the groups of claims are independent and distinct, as required by law. 35 USC §121 specifically states that the Commissioner may require the application to be restricted if it contains two or more "independent and distinct" inventions claimed in one application. 37 CFR §1.141 and §1.142 further repeat the language that the two or more inventions must be "independent and distinct".

MPEP §802.01 provides specific definitions of the meaning of the terms "independent" and "distinct". MPEP §802.01 states that the terms "independent" and "distinct" do not mean the same thing, but in fact have very different meanings. The term "independent", as set forth in MPEP §802.01, means that "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". The term "distinct"

means that "two or more subjects as disclosed are related, for example, as combination and part (sub-combination) thereof, ... and are patentable over each other".

The Examiner has set forth various reasons why the inventions are "distinct" from one another, by providing separate classifications for the groups, and by stating reasons why the groups are related. However, the Examiner has not met the burden of proving that the groupings are "independent" as required by the United States Code, the Code of Federal Regulations, and the Manual of Patent Examining Procedure. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and respectfully request that the requirement for restriction be withdrawn.

Applicants respectfully submit that MPEP §808.01 states that inventions are independent "where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration" and that "[t]his situation, except for species, is but *rarely present*, since persons will seldom file an application containing disclosures of independent things. (emphasis added). MPEP §806.04 cites the intended meaning of independent inventions by citing specific examples of independence, stating "[a]n article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example."

Applicants respectfully submit that the groups set forth by the Examiner cannot be considered "independent", since the specification clearly discloses the relationship between the subject matter of the claims of these groupings, and thus, the groupings are not wholly unrelated or "independent". Therefore, Applicants respectfully submit that the instant application is not properly restrictable, since the Examiner has not shown that the inventions are "independent" as required by the U.S. Statute.

Accordingly, in view of the above remarks, reconsideration of the requirement for restriction, and an action on all of the claims in the application, are respectfully requested.

Favorable action on the present application is earnestly solicited.

CONCLUSION

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the Percy L. Square at (703) 205-8034, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:

 #39,538

Joseph A. Kolasch
Reg. No.: 22,463


JAK/PLS:asc

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000